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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,858	09/25/2001	Jean J. Frechet	18062G-003510US	1612

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EXAMINER

TRINH, BA K

ART UNIT PAPER NUMBER

1625

DATE MAILED: 11/17/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,858

Applicant(s)

FRECHET ET AL.

Examiner

Ba K. Trinh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ^{days} 30 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/09/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1625

The restriction requirement as set forth in paper no. 4 (dated 05-09-03) is withdrawn. Thus, applicant's response filed on 06-09-03 had become moot. A new restriction requirement is hereby made.

Claim 8 is generic. In claim 8, A is an active group selected from NH, S, and O, however, in claim 9 which depends on claim 8, A is a component of a polymer.

Clarification is required in responding to this office action.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to anhydride and method of making the same, classified in class 549, subclass 370.
- II. Claims 8, 15-23, 33, 34-35, 38, 48, drawn to a dendrimer wherein A is an active group, classified in class 528, subclass 272.
- III. Claims 8, 9-11, 15-23, drawn to a dendrimer wherein A is polysaccharide, classified in class 536, subclass various.
- IV. Claims 8, 9-10, 12, 15-23, drawn to a dendrimer wherein A is poly (amino acid), classified in class 562, subclass various.
- V. Claims 8, 9, 13-14, 15-23, drawn to a dendrimer wherein A is a synthetic organic polymer, classified in class 528, subclass various.
- VI. Claims 24, 27-28, 31, 45, drawn to a dendrimer wherein A is a nucleic acid, classified in class 536, subclass various.
- VII. Claims 25 and 30, drawn to a dendrimer wherein A is a nucleic acid, classified in class 536, subclass various.

Art Unit: 1625

- VIII. Claims 8, 9, 10, 26, 29, 32, 38, drawn to wherein A or R⁸ is a nucleic acid, classified in class 536, subclass various.
- IX. Claims 8, 9, 10, 36-37, 38 drawn to wherein A is poly (alkylene oxide), classified in class 528, subclass various.
- X. Claims 8, 15-23, 39-40, 41-43, drawn to a protected dendrimer wherein A is an active group, classified in class 528, subclass various.
- XI. Claims 24, 44, 46-47, drawn to a dendrimer wherein A is an active group, classified in class 528, subclass various.

The above delineated groups are distinct and separate because the A moiety contains various radicals which are distinct me from another. For instance, nucleic acid is distinct from poly(amino acid), and etc.... In addition, the dendrimers contain submit having distinct moieties such as ether (OR⁵) and ester (O-CO-R) or a heterocyclic ring containing oxygen. A reference of one group would not suggest and/or render the other group obvious in the absence of the secondary teachings. A search of one group is not required for the search of other group. Thus, the restriction requirement as indicated is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is further required to elect a single disclosed species from the elected group for examination.

Art Unit: 1625

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is (703) 308-4545. The examiner can normally be reached on Monday-Friday 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Trinh/LR
November 4, 2003

BA K. TRINH
PRIMARY EXAMINER
GROUP 1200 / 625